REMARKS

I. Status of the Claims

Claims 1-31 were originally filed. Claims 7-9, 12, 17-26, 29, and 30 have been canceled. Claims 32-40 have been added. Currently, claims 1-6, 10, 11, 13-16, 27, 28, and 31-40 remain pending under examination.

II. Claim Rejections

A. 35 U.S.C. §102

Claims 1-5, 10, 11, 14-16, 27, 28, 31, 33, 35, 37, and 38 were rejected under 35 U.S.C. §102(e) for alleged anticipation by Wang *et al.* (U.S. Pat. No. 6,509,448). Applicants respectfully traverse the rejection.

To qualify as a pre-AIPA §102(e) prior art reference, a U.S. patent must have an effective filing date prior to the date of the underlying invention of a pending application. In the instant case, Wang *et al.* has an actual filing date of December 13, 2000, and is claiming priority to a series of prior U.S. patent applications. A closer inspection of the most immediate priority document, USSN 09/702,705 (now U.S. Patent No. 6,504,010), reveals that it does not contain the disclosure of Example 10 of Wang *et al.* and therefore does not describe the sequences in question, *i.e.*, SEQ ID NOs:1861-1864 of Wang *et al.* It is therefore clear that, as far as SEQ ID NOs:1861-1864 are concerned, Wang *et al.* is entitled to only its actual filing date as its effective filing date.

Because the December 13, 2000, actual filing date for Wang *et al.* is later than the filing date of the present application, October 6, 2000, Wang *et al.* cannot properly serve as a prior art reference to support a rejection under 35 U.S.C. §102(e). The withdrawal of the anticipation rejection based on Wang *et al.* is respectfully requested.

B. 35 U.S.C. §103

Wang et al. in view of Reed et al.

Claims 1,13, 27, 32, 34, 36, 39, and 40 were rejected under 35 U.S.C. §103(a) for alleged obviousness over Wang *et al.* in view of Reed *et al.* (U.S. Pat. No. 6,627,198). Applicants respectfully traverse the rejection.

Applicants contend that the Wang and Reed references cannot be used to form the basis of an obviousness rejection. As stated above, Wang *et al.* is not a §102(e) reference against the present application. Even if it were to be held a proper reference under §102(e), neither the Wang *et al.* reference nor the Reed *et al.* reference would be available as prior art references for the purpose of supporting a rejection under 35 U.S.C. §103(a). As set forth in 35 U.S.C. §103(c), subject matter developed by another person, which qualifies as prior art only under §102(e), (f), or (g), shall not preclude patentability under 35 U.S.C. §103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. In the instant case, Wang *et al.*, Reed *et al.*, and the present application were all assigned to, or obligated to be assigned to the same entity: Corixa Corp., at the time the present invention was made. Accordingly, no §103(a) rejection of the pending claims can be properly made based on Wang *et al.* and Reed *et al.*

As such, Applicants respectfully request that the obviousness rejection based on Wang *et al.* and Reed *et al.* be withdrawn.

Wang et al. in view of Watson et al.

Claims 1 and 6 were rejected under 35 U.S.C. §103(a) for alleged obviousness over Wang *et al.* in view of Watson *et al.* (U.S. Patent No. 6,566,072). Applicants respectfully traverse the rejection.

As discussed above, Wang *et al.* is not available as a §102 prior reference against the present application and is further not available as a §103(a) reference due to the common ownership. On the other hand, Watson *et al.* is cited to provide the element of a polynucleotide sequence encoding mammaglobin and does not relate to any Ra12 polynucleotide or polypeptide

sequence. Thus, the combination of the Wang and Watson references cannot support an obviousness rejection. The withdrawal of the §103(a) rejection on this ground is respectfully requested.

C. Provisional Double Patenting Rejection

Claims 1, 2, 11, 14, and 15 were provisionally rejected under the judicially created doctrine of double patenting over claims 1-4 and 7 of co-pending Application No. 09/780,669.

Applicants submit that the Examiner should withdraw the provisional double patenting rejections and allow the claims pending in the present application. According to the MPEP §822.01, "[i]f the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent..." This is precisely the case in the present application, as the only other rejections, the anticipation rejection based on Wang *et al.* and the obviousness rejection based on Wang *et al.* in view of Reed *et al.* or Watson *et al.*, are not properly established due primarily to the fact that Wang *et al.* and Reed *et al.* are not available as prior art references. On the other hand, USSN 09/780,669 has not been allowed. Thus, Applicants respectfully request that the Examiner withdraw the provisional double patenting rejection and allow the pending claims in the present application to issue.

If, however, a patent issues from USSN 09/780,669 prior to the allowance of the present application, Applicants will consider the possibility of filing a terminal disclaimer.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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